

Attorney Docket No. 7175-74147
Application No. 10/083,966 (Filed February 25, 2002)
Reply to Office Action dated June 17, 2004

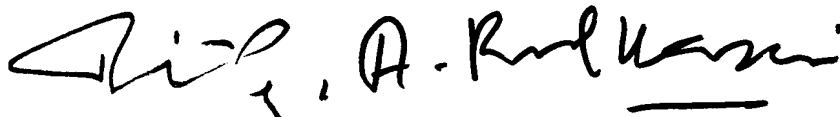
REMARKS

The following apparent errors are noted in the Office Action dated December 15, 2004: The cover sheet of said Office Action correctly lists the Application No. as 10/083,966. However, the Office Action Summary, the Detailed Action and the Notice of References Cited attached to the cover sheet all belong to Application No. 10/319,882. (See attached copy.) Accordingly, the applicants respectfully request that the Office Action dated December 15, 2004 be withdrawn and a new Office Action issued taking into account the claim amendments presented with this response.

In view of the foregoing amendment and supporting remarks, the subject application is now deemed to be in condition for allowance, and such action is respectfully requested. If the Examiner believes that a telephonic interview would expedite the allowance of this application, he is requested to contact the undersigned for a prompt resolution of any outstanding issues.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages and other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to file 7175-74147.

Respectfully submitted,
BARNES & THORNBURG



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,966	12/15/2004	Nicholas P. Van Brunt	7175-74147	2081

23643 7590 12/15/2004

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BARNES & THORNBURG LLP

EXAMINER

DEMILLE, DANTON D.

ART UNIT

PAPER NUMBER

3764

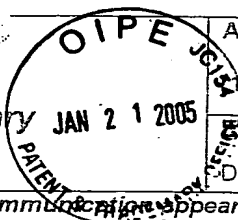
DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

FOR Office Act
BY [Signature]
DATE 12/20/04
CHECK'D BY _____
DATE _____

Office Action Summary



Application No.

10/319,882

Applicant(s)

POLVI, BRIAN A.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter or lacking patent eligibility.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

3. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

4. In the present case, though the present invention may eventually produce a useful, concrete, and tangible result, to the extent that it results in non-surgical methods of manipulating, facilitating and/or treating soft tissues and joints, it is not within the realm of technical arts. Rather, the subject matter involved is the pure practice of medicine, which, absent substantive or

non-trivial involvement of any machine, manufacture, or composition of matter, is merely a process within the realm of the liberal or social arts.

5. It is not apparent that the method claimed produces a useful, concrete, and tangible result. A method for "normalizing" soft tissue that includes no more than patient manipulation will produce reasonably predictable results and thus is not a sufficiently concrete invention.

Moreover, patient eligibility hinges on the Constitutional criterion of being within the useful arts, or more modernly, within the technological arts. Here, the method involves no substantive machine, manufacture or composition of matter and thus cannot be characterized as within the technological arts. Rather, this is a medical treatment method devoid of technological aspects and falling more properly into the realm of the social arts and the pure practice of medicine.

6. On the issue of "useful, concrete, and tangible" result, the applicant's attention should be invited to States Street Bank & Trust Co. v. Signature Financial Group Inc. 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and AT&T Corp. v. Excel Communications Inc., 173 F.3d 1352, 50 USPQ2d 1447 (Fed Cir. 1999).

7. On the "not within the technological arts" issue, the applicant's attention should be invited to the rationale in re Ex parte Bowman, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001) (Unpublished); In re Musgrave, 167 USPQ 280 (CCPA 1970); In re Foster, 169 USPQ 99 (CCPA 1974); In re Tomar, 197 USPQ 852 (CCPA 1978).

8. The following prior art exemplify the heart and obviousness of applicant's invention.

Claim Rejections - 35 USC § 103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:-

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sevier et al.**

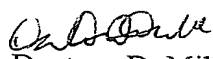
11. Sevier teaches the convention of normalizing soft tissue by applying pressure on the traumatized tissue and moving the pressure along the length of the traumatized tissue as shown in figure 16 for example.

12. **Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevier et al. in view of Tadlock.**

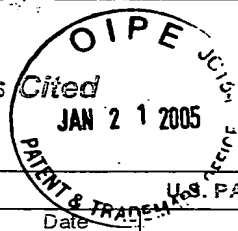
13. Tadlock teaches the method of administering anesthetic before massage, page 2, paragraph [0041]. It would have been obvious to one of ordinary skill in the art to modify Sevier to apply anesthetic before massage as taught by Tadlock to reduce pain and relax the muscles.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danton DeMille whose telephone number is (571) 272-4974. The examiner can normally be reached on M-Th from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Danton DeMille
Primary Examiner
Art Unit 3764

Notice of References Cited



Application/Control No.

10/319,882

Applicant(s)/Patent Under

Reexamination
POLVI, BRIAN A.

Examiner

Danton DeMille

Art Unit

3764

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,254,555	07-2001	Sevier et al.	601/135
	B	US-2003/0212350	11-2003	Tadlock, Mark	601/2...
	C	US-5,624,384	04-1997	Chen, Liu-Kin	601/84
	D	US-5,366,437	11-1994	Graston, David A.	601/135
	E	US-6,010,469	01-2000	McAtee, Robert E.	601/135
	F	US-6,077,239	06-2000	Lin, Jung-Miin	601/137
	G	US-5,817,037	10-1998	Zurbay, Gregory J.	601/135
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.